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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,696	06/26/2000	Philip Carragher	Carr-P1-00	4961

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,696

Applicant(s)

CARRAGHER ET AL.

Examiner

Stefano Karmis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 20, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to an Interview conducted on 07 October 2003.

Status of Claims

2. Claims 1-31 have not been amended and are under prosecution in this application.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Summary of this Office Action

4. Applicants' arguments have been fully considered, and discussed in the next section below or within the flowing rejection are not deemed to be persuasive. Therefore claims 1-31 are rejected under the art cited below and Applicants' request for allowance is respectfully denied.

Response to Applicants' Amendment

5. The Examiner acknowledges Applicants' arguments with respect to the final rejection in the previous office action and therefore withdraws the previous rejection. Any other arguments are moot in view of new grounds of rejection listed below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 4-5, 9-10, 12-20, and 28-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ogilvie U.S. Patent 6,631,358.

Regarding independent claim 1, Ogilvie discloses a method for card-activity based mortgage crediting, including the steps of associating card activity with a mortgage of a cardholder and crediting an amount to the mortgage responsive to the card activity (column 14, lines 47-67) and (column 5, lines 25-35). A computer system is used to generate output for the card activity and mortgage crediting (column 7, lines 18-30).

Claim 2, communicating a funds transfer to the cardholder (column 7, lines 18-30).

Claims 4 and 5, communicating electronic funds transfer to the mortgage servicer (column 7, lines 4-17).

Claim 9, the participant participates in the credit activity with the mortgage in response to an instruction from the cardholder by enrolling and selecting the mortgage sponsor (column 11, lines 5-48).

Claims 10 and 20, Ogilvie discloses allocation of credit activity between multiple saving vehicles such as mortgage payments.

Claims 12-14, changing an allocation of credit activity in response to instructions from the mortgage holder (column 9, line 28 thru column 10, line 16).

Claim 15, the step of changing is carried out in response to the instruction from the mortgage holder received over a network (column 6, lines 51-67).

Claim 16 and 23, allocating a portion of the credit activity between the mortgage and a charity issuing a tax deduction (column 4, lines 11-19 and column 5, lines 25-35).

Claims 17 and 18, computing an annual statement of the crediting and communicating the statement to the cardholder including all account activity (column 7, lines 18-30).

Claim 19, associating a monthly payment with the mortgage and communicating a funds transfer including the payment to a mortgage service provider (column 8, lines 32-49) and (column 9, lines 42-52).

Regarding independent claim 28 and claim 29, Ogilvie discloses a method for card-activity based mortgage crediting by electronic means, including the steps of associating card activity with a mortgage of a cardholder and crediting an amount to the mortgage responsive to the card activity (column 14, lines 47-67) and (column 5, lines 25-35). A computer system is programmed to generate output for the card activity and mortgage crediting and transfer of funds from computer to computer (column 7, lines 18-30).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 3, 6, 7-8, 11, 21-22, 24, 25-27 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie U.S. Patent 6,631,358 in view of DeLapa U.S. Patent 6,076,068.

Claims 3 and 6, Ogilvie teaches communicating a discount for the mortgage to a customer by electronic means. Ogilvie fails to teach printing a check, a coupon for the mortgage and combining them with a statement of card activity in an envelope and addressing to the cardholder. DeLapa teaches a coupon delivery system in which that provides targeted coupons based on purchases by a household (Abstract). DeLapa teaches prior art in which coupons are placed in an addressed envelope and mailed to the customer (column 2, lines 20-65). DeLapa fails to teach including in the envelope a statement and check. Official Notice is taken that providing account information is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to allow for statements and checks to be included in the envelope because they communicate to the cardholder the manner in which the coupon is received.

Regarding claims 25-27 and 30-31, Ogilvie teaches communicating a discount for the mortgage to a customer by electronic means. Ogilvie fails to teach printing a check, a coupon for the mortgage and combining them with a statement of card activity in an envelope and addressing to the cardholder. DeLapa teaches a coupon delivery system in which that provides targeted coupons based on purchases by a household (Abstract). DeLapa teaches prior art in which a kiosk can receive electronic instruction to print coupons and have them placed in an addressed envelope and mailed to the customer (column 2, lines 20-65). DeLapa fails to teach

including in the envelope a statement and check. Official Notice is taken that providing account information is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to allow for statements and checks to be included in the envelope because they communicate to the cardholder the manner in which the coupon is received.

Claims 7 and 8, Ogilvie teaches a periodic statement summarizing account activity and reflecting any savings benefit. Ogilvie fails to specify teaching forecasting repayment of the mortgage in the output communicated to the cardholder. Official Notice is taken that forecasting payments is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to include forecasting on the periodic statements because it provides financial information relating to the transaction which greater assists the cardholder's understanding of account.

Claim 11, Ogilvie teaches allocating a portion of the credit activity to the principal of the mortgage. Ogilvie fails to teach allocating a portion of credit activity between interest and principle for the mortgage in response to instructions from a cardholder. Official Notice is taken that payment on interest is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art that the teachings of Ogilvie could be modified to include allocating a portion of credit activity between interest and principle for the mortgage in response to instructions from a cardholder because it allows for a more diverse and efficient system and greater allows the cardholder to instruct payment options.

Claims **21**, Ogilvie teaches that the participant participates in the credit activity with the mortgage in response to an instruction from the cardholder by enrolling and selecting the mortgage sponsor (column 14, lines 47-67) and (column 5, lines 25-35). Ogilvie fails to teach the ability to allocate credit activity from a second cardholder. Official Notice is taken that funding from a second cardholder is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art to include allocating credit activity from a second cardholder because any number of cards could be added to associate card activity with the mortgage since they all perform in the same manner as the original card used to fund the mortgage.

Claim **22**, Ogilvie teaches a computer system is used to generate output for the card activity and mortgage crediting (column 7, lines 18-30) for a first cardholder. Ogilvie fails to teach generating the output for a second cardholder. Official Notice is taken that funding from a second cardholder is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art to include allocating credit activity from a second cardholder because any number of cards could be added to associate card activity with the mortgage since they all perform in the same manner as the original card used to fund the mortgage.

Claim **24**, Ogilvie fails to teach the use of a second computer for mortgage-backed security in response to indicia of crediting. Official Notice is taken that valuations are old and

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well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention that a computer could be used to compute a valuation of mortgage-backed security because it helps provide a better understanding of the performance of the mortgage in the system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
October 20, 2003



HANI M. KAZIMI
PRIMARY EXAMINER